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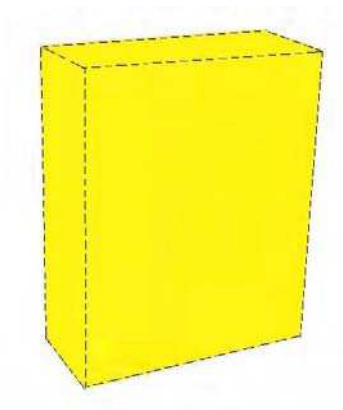
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In re Application of: GENERAL MILLS IP HOLDINGS II, LLC



Mark:

Serial No.: 86/757,390

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**APPLICANT'S REPLY BRIEF**

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## **Introduction**

In the Examining Attorney's appeal brief ("Opp."), the Examining Attorney persists with the assertion that Applicant's Cheerios Yellow Box Mark has not acquired distinctiveness despite the extensive evidence of secondary meaning made of record by Applicant. In so doing, the Examining Attorney continues to rely upon numerous misstatements of law and fact.

The Examining Attorney erroneously contends that substantially exclusive use is, in effect, the only relevant factor to the secondary meaning analysis, mischaracterizes the significance and relevance of her limited online research into alleged third party uses, and fails to rebut the overwhelming and arguably unprecedented level of direct and circumstantial evidence of acquired distinctiveness submitted by Applicant to support registration.

Applicant's Cheerios Yellow Box Mark has acquired distinctiveness, the Examining Attorney's refusal and arguments in support of the refusal are erroneous and contrary to well-settled Board and Federal Circuit precedent, and the refusal of the application must be reversed.

### **I. The Examining Attorney Has Not Rebutted Applicant's Prima Facie Case of Acquired Distinctiveness**

As discussed in Applicant's appeal brief, an applicant is required to establish a *prima facie* case of acquired distinctiveness in order to obtain registration. *Yamaha International Corp. v. Hoshino Gakki Co., Ltd.*, 6 USPQ2d 1001, 1004 (Fed. Cir. 1988) ("When registration is sought under Section 2(f), the board publishes the mark for opposition when it is satisfied that the applicant has presented a prima facie case of acquired distinctiveness"); *see also In re Capital Formation Counselors, Inc.*, 219 USPQ 916, 919 (TTAB 1983) ("[A]n applicant need not conclusively establish distinctiveness, but rather need only establish a prima facie case" in order to warrant publication of the mark for opposition). The Federal Circuit has also instructed that it is inappropriate for the Board to place an improperly heavy evidentiary burden on applicants for color marks. *See In re Owens-Corning Fiberglas Corp.*, 227 USPQ 417, 425 (Fed. Cir. 1985) ("We conclude that the Board placed an inappropriately heavy evidentiary burden on [the applicant for a color mark]...there is nothing in the

statute ‘which expressly or impliedly imposes an unreasonable burden of proof upon an applicant for registration thereunder, nor is it within our province to read such rigid provisions into it.’”).

Applicant has presented a *prima facie* case that the Cheerios Yellow Box Mark has acquired distinctiveness, as proved by a variety of the specific types of direct and circumstantial evidence the courts and the Board are to look for in assessing secondary meaning. This evidence includes: Applicant’s survey evidence, extensive evidence of unsolicited media coverage and consumer statements touting the fame of the Cheerios Yellow Box Mark, Applicant’s advertising efforts and billions of dollars in advertising expenditures, Applicant’s “look-for” advertising, Applicant’s billions of dollars in product sales, the evidence of the copying of the Cheerios Yellow Box Mark by Applicant’s competitors, and Applicant’s long, continuous use of the Cheerios Yellow Box Mark.

Rather than addressing this evidence, the Examining Attorney hinges her attempt to rebut Applicant’s *prima facie* case on the erroneous position that Applicant’s use of the Cheerios Yellow Box Mark has not been substantially exclusive, and therefore the Cheerios Yellow Box Mark is incapable of achieving secondary meaning as a matter of law (and regardless of Applicant’s compelling evidence on the other secondary meaning factors). For example, the Examining Attorney’s brief closes by arguing:

*[T]he key consideration here is that applicant's use of the color on its cereal boxes is not substantially exclusive and therefore is insufficient to show secondary meaning or acquired distinctiveness. Although applicant appears to have used the yellow color on its cereal boxes for a long period of time and has promoted the color in a few advertisements, it is clear from the evidence of record that applicant has not established that the use is substantially exclusive as required by Trademark Act Section 2(f) and thus the Trademark Act Sections 1, 2 and 45 refusal was maintained and made final.”*

Opp. at 13 (emphasis added).

While, for the reasons discussed below and in Applicant’s appeal brief, Applicant strongly disputes the Examining Attorney’s assertion that Applicant’s use of the Cheerios Yellow Box Mark has not been substantially exclusive, it must first be noted that the Examining Attorney’s contention that substantially exclusive use is a statutory prerequisite for registration under Section 2(f) of the Trademark Act is wrong and an erroneous statement of law.

Continuous, longstanding, substantially exclusive use is circumstantial evidence of acquired distinctiveness and one of several factors courts and the Board are to consider when assessing secondary meaning. But just as evidence of exclusive use, by itself, may not be sufficient to establish secondary meaning, evidence that the mark owner's use has not been exclusive is by no means outcome determinative. *See e.g.*, 2 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 15:27 (4<sup>th</sup> ed.) (“McCarthy”) (“The quantity and quality of third party use is *not alone determinative* and *must be weighed along with other evidence.*”) (emphasis added). The appropriate assessment is not whether Applicant's use of its mark has been substantially exclusive, but rather whether, when all of Applicant's direct and circumstantial evidence of secondary meaning evidence is considered, with exclusivity being one factor, Applicant has established a *prima facie* case that consumers associate Applicant's Cheerios Yellow Box Mark with a single source. *Id.* (“[T]he issue is not whether plaintiff's use was exclusive, but whether plaintiff's use of the mark had achieved secondary meaning, as opposed to anyone else's use of a similar mark.”); *accord Royal Crown Company, Inc. and Dr. Pepper/Seven Up, Inc. v. The Coca-Cola Company*, Oppositions Nos. 91178927, et al. at \*29-30 (TTAB May 23, 2016) (non-precedential) (citing McCarthy and finding that evidence of third party use of ZERO, including “substantial” use by opposer, does not rebut the applicant's claim of substantially exclusive use of ZERO in view of the “magnitude” of the applicant's use and the lack of “record evidence of the public's understanding of the significance of” the opposer's ZERO mark).

As Applicant noted in its appeal brief, the only mention of “substantially exclusive” use in Section 2(f) is in the context of a type of claim that Congress has authorized the Director to accept as *prima facie* evidence of acquired distinctiveness; namely, a declaration by the applicant that a mark has acquired distinctiveness based on “proof of substantially exclusive and continuous use...for the five years before the date on which the claim of distinctiveness is made.” 15 U.S.C. § 1052(f).<sup>1</sup> But there is no provision of the statute, supporting

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<sup>1</sup> The phrase “substantially exclusive and continuous use” is only used in the supporting regulations and the Trademark Manual of Examining Procedure (TMEP) in the context of describing this particular type of five year *prima facie* claim under 2(f). 37 C.F.R. § 2.41(a); TMEP § 1212 (October 2016). A declaration of five years of substantially exclusive and continuous use, however, is certainly not the only basis by which an

regulations, or jurisprudence on the issue that can be reasonably interpreted as reflecting an intention by Congress to require substantially exclusive use as a threshold prerequisite for a finding of acquired distinctiveness, or that compelling evidence strongly weighing in favor of acquired distinctiveness must be ignored and dismissed if there is any indication that the applicant's use is not substantially exclusive.

To the contrary, the courts and the Board have consistently considered exclusivity of use as just one of multiple factors to consider when determining whether a mark has achieved acquired distinctiveness. As stated by the Second Circuit:

In determining whether a mark has acquired secondary meaning, we have examined: (1) advertising expenditures, (2) consumer studies linking the name to a source, (3) sales success, (4) unsolicited media coverage of the product, (5) attempts to plagiarize the mark, and (6) length and exclusivity of the mark's use. In assessing the existence of secondary meaning, *no single factor is determinative, and every element need not be proved*. Each case, therefore, must be resolved by reference to the relevant factual calculus.

*Thompson Medical Company, Inc. v. Pfizer*, 225 USPQ 124, 132 (2d Cir. 1985) (emphasis and parentheticals added; internal citations and omitted); *see also In re Steelbuilding.com*, 75 USPQ2d 1420, 1424 (Fed. Cir. 2005) (“In determining whether secondary meaning has been acquired, the Board may examine copying, advertising expenditures, sales success, length and exclusivity of use, unsolicited media coverage, and consumer studies (linking the name to a source)”; *In re Koninklijke Philips Elecs. N.V.*, 112 USPQ2d 1177, 1180 (TTAB 2014).

The Examining Attorney's repeated insistence throughout the prosecution of the application and appeal that her internet evidence of alleged third party uses is by itself sufficient grounds to conclude that Applicant's Mark has not achieved secondary meaning under Section 2(f) is premised on a mischaracterization of the law. And because the Examining Attorney has improperly elevated “substantially exclusive use” to an absolute requirement, she has also repeatedly failed to afford Applicant's other secondary meaning evidence

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applicant can establish acquired distinctiveness. *See* 37 C.F.R. 2.41(a)(1), (3); TMEP §§ 1212, 1212.01, 1212.03, 1212.06.



the appropriate weight under the statute, supporting regulations, the TMEP, and the relevant jurisprudence at all stages of prosecution.<sup>2</sup>

## **II. The Examining Attorney's Evidence Does Not Rebut Applicant's Claim of Acquired Distinctiveness**

Despite the fact that Applicant need not prove that its use of the Cheerios Yellow Box Mark has been substantially exclusive in order to present a *prima facie* showing of acquired distinctiveness, Applicant reiterates that its use of the Cheerios Yellow Box Mark with Applicant's goods has been substantially exclusive and that the limited internet evidence relied upon by the Examining Attorney does not come close to rebutting Applicant's overwhelming evidence of secondary meaning.

It is beyond dispute that Applicant's use of the Cheerios Yellow Box Mark does not need to be universally exclusive in order to be considered "substantially exclusive." The Federal Circuit has instructed that third party uses that are infringing or inconsequential do not invalidate a claim of substantially exclusive use. *L.D. Kichler Co. v. Davoil, Inc.*, 52 USPQ2d 1307, 1309 (Fed. Cir. 1999). Moreover, the Examining Attorney does not credibly address the arguments raised by Applicant about the deficiencies and irrelevance of the Examining Attorney's internet search results.

First, in response to Applicant's argument that several of the alleged third party uses are irrelevant because they do not show use of the Cheerios Yellow Box Mark or even a similar color scheme with Applicant's goods, the Examining Attorney contends, without citation or support, that:

[T]he amount of yellow on applicant's specimen of record that is considered 'predominant uniform background color' is the same as the amount of yellow on most if not all of the third parties' cereal boxes... Consumers are unlikely to measure how much of the color yellow

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<sup>2</sup> The influence this flawed analysis has had on the prosecution of the application can be seen from the Examining Attorney's very first communication to Applicant. As discussed in Applicant's appeal brief, when Applicant's counsel reached out to the Examining Attorney to determine why the secondary meaning evidence Applicant submitted on a DVD with the application had not been made of record, the Examining Attorney stated, without having reviewed any of the Applicant's evidence contained on the DVD: "any DVD or survey you send would not overcome the refusal or the denial of the Section 2(f) claim because (a) the mark is not inherently distinctively and (b) applicant does not have 'substantially exclusive' use of the color on the box. The evidence of record confirms that many third parties offer cereal in yellow boxes." See March 30, 2016 email from Tasneem Hussain attached as Exhibit B to Applicant's October 2, 2016 Appeal Brief.

alone is featured on certain portions of a cereal box to determine the source of the goods.

Opp. at 8.

This is not only inaccurate, it is completely devoid of any support or evidence—just saying that “consumers are unlikely to measure how much of the color yellow alone is featured on certain portions of a cereal box to determine the source of the goods” does not make that true. And the application does not seek to register any and all uses of the color yellow on cereal packaging, but rather the specific mark shown in the drawing: the specific yellow color appearing as the solid, uniform background color of the product packaging for the Applicant’s toroidal-shaped, oat-based breakfast cereal. Third party uses that feature some depiction of the color yellow as a component of a different color scheme, such as the boxes featuring a yellow stripe at the top or bottom of an otherwise white box submitted by the Examining Attorney, are plainly different and distinguishable from the mark shown in Applicant’s drawing. The Examining Attorney’s assertion that consumers will be unable to differentiate between different color schemes is unsupported and surely not reflective of the actual marketplace conditions.

Second, as explained by Applicant in detail in its May 18, 2016 Response to Office Action and its appeal brief, many of the alleged third party uses made of record by the Examining Attorney are unreliable due to the fact that they are presented without sufficient context to indicate that the uses are genuine, current, offered within the United States, or, most importantly, have significant sales or distribution such that they would impact consumer perceptions (e.g., the uses that appear only on a blank white webpage without any surrounding content and without sales or distribution data). As the Board noted in *In re Carl Walther GmbH*, Serial No. 77/096,523 at \*17 (TTAB October 26, 2010) (non-precedential), internet printouts of alleged third party uses are of limited probative value without any information on “the degree of consumer exposure to the third party [products] or whether they are actually in production.” The Examining Attorney does not respond to this argument, and presumably concedes the point.

Third, as Applicant explained in its appeal brief, if certain of the third party uses submitted by the Examining Attorney are genuine actual uses, then many if not all of these uses are attempts to copy and trade

off of Applicant's established rights in the Cheerios Yellow Box Mark, which weighs in favor of acquired distinctiveness. In her appeal brief, the Examining Attorney dismisses Applicant's argument by simply concluding that "[w]hether others are infringing on applicant's goodwill is not the issue here." Opp. at 7. This, however, reflects a misunderstanding of the law; if the alleged third party uses are infringing uses, then they do not invalidate Applicant's claim of substantially exclusive use. To the contrary, they support Applicant's claim of acquired distinctiveness. *See e.g.*, McCarthy §15:38 (stating that evidence of copying is probative evidence of secondary meaning); *Knorr-Narhmittel A.G. v. Reese Finer Foods, Inc.*, 9 USPQ2d 1309, 1313 (D.N.J. 1988) (finding evidence that the defendant instructed its package designer to copy the plaintiff's trade dress to be sufficient evidence, by itself, to find secondary meaning). In fact, some federal circuits have gone so far as to hold that evidence of third party copying, by itself, triggers a presumption of secondary meaning. *See e.g.*, *Larsen v. Terk Technologies Corp.*, 47 USPQ2d 1429, 1436 (4th Cir. 1998) (finding that evidence of intentional copying triggers presumption of secondary meaning); *Esercizio v. Roberts*, 20 USPQ2d 1001, 1005 (6th Cir. 1991) ("Arguably, secondary meaning in this case can be presumed from [defendant's] admissions that he intentionally copied [plaintiff's] design.").

Finally, the Examining Attorney has not credibly addressed Applicant's argument that, even if these alleged third party uses are genuine, current uses within the United States, Applicant's survey evidence, unsolicited media evidence, and sales and advertising evidence demonstrate that these uses are inconsequential. That is, if the internet uses the Examining Attorney bases the refusal on were consequential and conclusively establish no secondary meaning, then it naturally follows that Applicant would be unable to submit direct survey evidence with a high response rate of consumers associating the Cheerios Yellow Box Mark specifically with Applicant or extensive unsolicited media references to Applicant's "signature," "trademark," "distinctive," and "iconic" yellow box. The Examining Attorney has not made of record any supporting evidence that her internet uses are consequential, and the precedent is clear that the mere fact that products can be found online does not permit the assumption that consumers have encountered these products or that these products have any effect on consumer purchasing decisions, particularly if there is other direct evidence

indicating that these products have had little if any impact. *See e.g., In re Carl Walther GmbH*, at \*17, (dismissing the probative value of printouts of alleged third party products without any sales or distribution info for such products and noting that such evidence “does not rise to the level necessary to rebut the direct and circumstantial evidence presented by the applicant.”); *T-Mobile US, Inc. v. Aio Wireless LLC*, 991 F. Supp. 2d 888, 913 (S.D. Tex. 2014) (finding defendant’s evidence of third party uses of magenta color does not rebut plaintiff’s claim of acquired distinctiveness in color since “[i]dentifying other uses of magenta in marketing is not prima facie evidence that those uses have affected how the public views magenta in the wireless-telecommunications industry. The court has not been provided with information about the extent and effect of the purported third-party use. [Defendant’s] argument does not undermine this court’s findings of fact and conclusions of law on secondary meaning.”).

The Examining Attorney responds to Applicant’s argument by misstating the legal standard for proving secondary meaning and asserting, without any supporting citations, that:

Case law confirms that the burden of proving that a mark has acquired distinctiveness based on substantially exclusive use is on the applicant. The examining attorney does not have a burden to show the reverse; it is enough to show there is voluminous evidence of third party usage in the marketplace today to negate applicant’s claim of substantially exclusive use of the color on its packaging.

Opp. at 9.

To the contrary, case law confirms that an applicant has the burden of establishing a *prima facie* claim of acquired distinctiveness by submission of direct and circumstantial evidence that supports such a claim under the well-settled multi-factor analysis. *Yamaha International Corp.* at 1004. Moreover, while Applicant disagrees that it has the burden of proving the negative that the unsubstantiated internet evidence submitted by the Examining Attorney is inconsequential, it submits that it has amply done so with its direct evidence showing that the Cheerios Yellow Box Mark has achieved acquired distinctiveness.

The Examining Attorney’s appeal brief also suggests that she has no obligation to provide supporting evidence for her alleged internet uses due to the fact that “the USPTO has limited resources for obtaining evidence when examining applications for registration; the practicalities of these limited resources are routinely

taken into account when reviewing a trademark examining attorney's action." Opp. at 9 (citing *In re Pacer Technology*, 67 USPQ2d 1629 (Fed. Cir. 2003)). However, the limited resources of the USPTO cannot be a sufficient justification for the Board or the Examining Attorney to make significant assumptions regarding the effect of unsupported internet evidence on the question of acquired distinctiveness, particularly where there is direct and circumstantial evidence of record that contradicts such assumptions. The cited case of *Pacer Technology* does not support the Examining Attorney's argument, since that case involved a refusal on the grounds that the applicant's mark was not inherently distinctive, and such a refusal requires the Office to make only a *prima facie* showing that the applied-for mark is not inherently distinctive; thus, the Office was not required to provide evidence that was beyond its limited resources in order to make a *prima facie* case in support of the refusal. *Id.* at 1632 ("In proffering the design patents, some of which belonged to Pacer's competitors, the PTO was not obliged to do more to meet its *prima facie* burden. We are mindful of the reality that the PTO is an agency of limited resources."). Unlike *Pacer*, in the present case Applicant has the burden of making a *prima facie* case of acquired distinctiveness, and if anything the Examining Attorney's limited resources concerns support the rule that any doubt on the fact-intensive question of acquired distinctiveness must be resolved in an applicant's favor. See e.g., *In re Carl Walther GmbH* at \* 17 (finding secondary meaning, dismissing the examiner's unsubstantiated evidence, and noting that "the examining attorney is somewhat handicapped inasmuch as he does not have access to the same evidentiary resources as counsel for applicant or that of a party in an *inter partes* proceeding.").

The other cases primarily relied upon by the Examining Attorney for the position that her internet evidence single handedly trumps Applicant's evidence, *Levi Strauss & Co. v. Genesco, Inc.*, 222 USPQ 939 (Fed. Cir. 1984) (involving an orange tab on a shoe) and *Target Brands, Inc. v. Hughes*, 85 USPQ2d 1676, 1682-83 (TTAB 2007) (involving the mark "Ultimate Polo") (Opp. at 7), are easily distinguishable from the present case. Beyond the maxim that every case of acquired distinctiveness must be decided on its own merits, these cases are *inter partes* cases in which the third party uses were amply supported and substantiated by relevant evidence and testimony such that the Federal Circuit and the Board were able to determine that the

third party uses were substantial. That is not the case here, as there is no actual sales data for these alleged third party uses, there is no evidence that the uses are genuine or valid, let alone substantial, and Applicant's direct survey evidence strongly supports the inference that these uses have not been substantial, as it shows that consumers associate the Cheerios Yellow Box Mark specifically with Applicant.

Moreover, in both of these cases the applicant's claim of acquired distinctiveness was supported only by circumstantial evidence, such as sales, length of use, and advertising expenditures (all of which was substantially less than Applicant's evidence here). The plaintiffs did not submit survey evidence, "look-for" advertising, or unsolicited media praise touting the fame of the marks at issue. The Federal Circuit and the Board thus did not have any direct evidence from which to infer acquired distinctiveness and the circumstantial evidence was limited. In contrast, Applicant has submitted not only a substantial amount of circumstantial evidence showing its efforts to promote the Cheerios Yellow Box Mark, but also a substantial amount of direct evidence confirming that these efforts have successfully formed a syndetic relationship between the Cheerios Yellow Box Mark and a single source in the minds of a significant part of the purchasing public.

The evidence, arguments, and authority referenced by the Examining Attorney do not rebut Applicant's claim of substantially exclusive use in view of the other highly probative evidence of acquired distinctiveness made of record by Applicant. In addition, the Examining Attorney's appeal brief reveals that she has afforded scant attention and insufficient weight to Applicant's evidence of acquired distinctiveness.

### **III. The Examining Attorney's Brief Grants Insufficient Weight to Applicant's Evidence of Acquired Distinctiveness**

#### **1. Applicant's Sales and Advertising Expenditures**

In her appeal brief, the Examining Attorney dismisses Applicant's monumental sales figures (over \$4 billion U.S. dollars in just the past decade alone)<sup>3</sup> and advertising figures (over \$1 billion U.S. dollars in just the past decade)<sup>4</sup> by merely asserting that these figures are not dispositive standing alone, and "[n]one of the

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<sup>3</sup> September 15, 2015 Application, TSDR pg. 61 (Declaration of James Murphy at ¶ 18)

<sup>4</sup> September 15, 2015 Application, TSDR pg. 59 (Declaration of James Murphy at ¶ 9)

sales figures and advertising expenditures indicates how much applicant actually spent associating yellow with the goods or promoting the color yellow as an indicator of source. In any event, applicant's sales evidence does not support the contention that the color has acquired distinctiveness in the public's eye." Opp. at 11. The Examining Attorney's contention that Applicant's billions of dollars in sales and advertising expenses going back to the 1940s (which are consistent with or well above the types of figures that the Board and the courts have found weigh in favor of acquired distinctiveness) do not in any way support Applicant's claim of acquired distinctiveness is a clear error. *See In re Black & Decker Corp.*, 81 USPQ2d 1841, 1844 (TTAB 2006) (total sales exceeding \$500 million between 2000 and 2004 found to be "substantial" and supporting finding that applicant's key head design has acquired distinctiveness); *Companhia de Bebidas das Américas - AMBEV v. The Coca Cola Co.*, Opposition Nos. 91178953, et al. at \*17 and 20 (TTAB May 2, 2012) (non-precedential) (finding applicant's sales of over \$4 billion of its ZERO line of beverages to be "significant numbers by any measure" and reasoning that opposer's "attempt to show that the ZERO marks have not acquired distinctiveness simply fails in light of the scope of [applicant]'s significant sales and marketing numbers.").

## **2. Applicant's Advertising Evidence**

As stated in its initial appeal brief, Applicant has invested significant amounts of time, money, and effort in promoting the Cheerios Yellow Box Mark through a variety of different means. As shown by the sample advertisements in the record, Applicant's advertising features two consistent themes that reinforce consumers' associations of the Cheerios Yellow Box Mark with a single source: (1) prominent and repeated depictions of Applicant's signature bright yellow cereal box, and (2) other complementary uses of the signature yellow color of Applicant's mark in various contexts, such as the yellow color of text, the yellow color of the advertisement background, the yellow color of the clothing of the "hero" of the commercial, and the yellow color of the Cheerios cartoon mascot. As shown by Applicant's direct evidence, as a result of these efforts consumers have learned to associate the CHEERIOS brand with the signature yellow color of the Cheerios Yellow Box Mark.

In her appeal brief, the Examining Attorney attempts to minimize the probative value of Applicant's advertising evidence by arguing that:

Applicant's evidence confirms that applicant is promoting the wording 'CHEERIOS' as the trademark for the goods rather than the color as a trademark. Moreover, in the advertisements of record applicant always uses the color with its other trademarks. The color does not make its own separate commercial impression... Most of the evidence makes reference to the goods featuring the wording ("CHEERIOS") but not the mark (a yellow box). This lack of evidence promoting this particular color as applied to the goods is insufficient to support a claim of acquired distinctiveness.

Opp. at 10.

The Examining Attorney's apparent contention that only explicit "look-for" advertising can serve to foster a mental connection by consumers between a color and a brand is unsupported and ignores the realities of the marketplace. The evidence of record clearly shows that Applicant has long used and advertised the signature color of the Cheerios Yellow Box Mark in connection with the CHEERIOS brand, and the direct evidence shows that consumers have learned to associate the color with the brand. Thus, this evidence can only weigh in favor of a finding of secondary meaning.

### **3. Applicant's "Look-For" Evidence**

Throughout the prosecution of Applicant's Mark, the Examining Attorney alleged that Applicant's lack of "look-for" advertising of the Cheerios Yellow Box Mark supported her refusal. After Applicant identified in its May 18, 2016 Response to Office Action and appeal brief the "look-for" advertising of the Cheerios Yellow Box Mark made of record, the Examining Attorney abandons this allegation in her brief. Instead, she attempts to minimize the probative value of this evidence by asserting that Applicant has submitted "only four" audio-visual commercials featuring look-for advertising, and arguing that "[a]lthough given the opportunity, applicant was unable to provide any *print* evidence of its promotion of the yellow color alone as a source indicator." Opp. at 11 (emphasis added). These arguments are unpersuasive for multiple reasons.

At the outset, as shown by Applicant in its appeal brief, courts and the Board have repeatedly concluded that explicit advertising whereby the advertisements specifically tell consumers to "look for" the mark at issue is not critical or required for a finding of acquired distinctiveness. Nonetheless, such evidence is supportive of



a claim of secondary meaning, and the Examining Attorney cites no authority setting forth a threshold amount of “look-for” advertising that is necessary to support such a finding. Four nationally-aired television commercials featuring clear “look-for” advertising should do nothing but strongly support Applicant’s claim of acquired distinctiveness, and the Examining Attorney does not provide any argument or authority specifying why this evidence should be ignored or minimized other than her insinuation that some unknown number of additional commercials is required for a finding of secondary meaning.

Moreover, leaving aside the Examining Attorney’s unsupported and illogical insinuation that Applicant must show “print evidence” of its promotion of the Cheerios Yellow Box Mark in order for its “look-for” advertising to be probative, the Examining Attorney is simply incorrect that Applicant was unable to provide any print evidence of its promotion of the yellow color alone as a source indicator. Applicant submitted as Exhibit R to its May 18, 2016 Response to Office Action several screenshots from Applicant’s websites and official Twitter account promoting the association between the Cheerios brand and “our famous yellow box,” “that iconic yellow box,” and “familiar yellow boxes.” *See* May 18, 2016 Response to Office Action, TSDR pgs. 147, 151, and 156. The Examining Attorney’s factually incorrect characterization of the evidence of record in her appeal brief also undermines her claim to have “carefully reviewed” the evidence submitted by Applicant, and supports Applicant’s claim that the Examining Attorney has not accorded Applicant’s evidence sufficient weight and consideration in her analysis.

#### **4. Applicant’s Unsolicited Media Coverage and Consumer Statements**

Applicant has made of record extensive evidence of unsolicited media coverage and consumer statements showing a clear understanding by consumers that the Cheerios Yellow Box Mark serves as a source-identifier of the Applicant, including numerous articles that reference Applicant’s “famous,” “iconic,” “trademark,” “signature,” or “distinctive” yellow box. *See, e.g.*, May 18, 2016 Response to Office Action, TSDR pgs. 158, 160, 164, 166, 168, 170, 182, 193, 196, 206, 211, 216, and 232. Despite clear precedent establishing that unsolicited media coverage is a significant factor to be considered in a determination of secondary meaning, the Examining Attorney responds to this evidence in her appeal brief with complete

silence. The Examining Attorney also failed to make of record any contrary evidence of media coverage or consumer statements showing consumers associate the Cheerios Yellow Box Mark with a party other than Applicant. The Examining Attorney's complete failure to address Applicant's evidence of unsolicited media coverage and consumer statements belies her repeated insistence in her appeal brief that Applicant has not submitted evidence demonstrating that consumers associate the Cheerios Yellow Box Mark with Applicant and understand that the mark serves a source-identifying function.

## **5. Applicant's Survey Evidence**

Perhaps most critically, the Examining Attorney completely fails to address the highly probative value of Applicant's survey evidence, despite the fact that such evidence has been universally recognized by courts as the "preferred," "preferable," "most persuasive," and "most direct and persuasive" method of proving acquired distinctiveness. *Yankee Candle Co. v. Bridgewater Candle Co.*, 59 USPQ2d 1720, 1727 (1st Cir. 2001); *Berner Int'l Corp. v. Mars Sales, Co.*, 26 USPQ2d 1044, 1050 (3d Cir.1993); *Vision Sports, Inc. v. Melville Corp.*, 12 USPQ2d 1740, 1744 (9th Cir. 1989); *Amazing Spaces Inc. v. Metro Mini Storage*, 95 USPQ2d 1333, 1349 (5th Cir. 2010) (quoting *Sno-Wizard Mfg., Inc. v. Eisemann Prods. Co.*, 230 USPQ 118, 120 (5th Cir. 1986)).

Applicant submitted a consumer survey conducted by an accomplished academic and highly reputable expert that has been retained as an expert witness in numerous trademark proceedings. 52.7% of the test subjects, or, adjusting for control, an absolute minimum of 48.3% of the test subjects, specifically identified Cheerios as the cereal contained in the yellow test box, and made this determination based on the yellow color of the box. May 18, 2016 Response to Office Action, TSDR pg. 277. This survey is particularly impressive since it shows that approximately half of the respondents associated the yellow test mark specifically with Applicant, not just with an anonymous single source (which is all that is needed to show acquired distinctiveness). Applicant's initial appeal brief cites a multitude of different decisions by the Board, the Federal Circuit, circuit courts, and district courts unanimously concluding that a comparable rate of consumer recognition of a mark merely with a single anonymous source—let alone specifically with a named applicant or

brand—weighs in favor of a finding of secondary meaning. *See, e.g., In re Owens-Corning Fiberglas Corp.* at 424-25 (“Consumer recognition in 1981 as to the source of ‘pink’ insulation was 50%, a percentage considerably greater than that held sufficient in many cases.”); *T-Mobile US, Inc.* at 906 (survey showing 49% of subjects associate magenta color specifically with the plaintiff supports finding of secondary meaning); *In re Hershey Chocolate and Confectionary Corp.*, Serial No. 77/809,223 at \*14-15 (TTAB June 28, 2012) (non-precedential) (“After adjusting for the control group, approximately 42% of the survey participants correctly identified applicant as the maker of the candy bar....These percentages are significant when compared to previous cases where secondary meaning or acquired distinctiveness in a mark has been established.”). The Examining Attorney does not cite to any case declining to find secondary meaning with survey evidence comparable to that submitted by Applicant.

Incredibly, the Examining Attorney actually argues that “[t]here is no indication that the public, upon encountering a plain yellow box with no other wording or designs, would be able to discern that the goods originated with applicant alone.” *Opp.* at 9. The Examining Attorney makes this assertion in the face of a record featuring a consumer survey in which half of the members of the public did exactly that.

Despite Applicant’s survey evidence and the undisputed significance of such evidence in a determination of secondary meaning, the Examining Attorney’s appeal brief devotes a mere paragraph to Applicant’s survey, summarily dismissing the value of the survey by asserting that it does not show “an overwhelming recognition” of the Cheerios Yellow Box Mark as a source-identifier. *Opp.* at 12. The Examining Attorney does not cite to any authority for her assertion that “overwhelming recognition” must be shown in order to prove a *prima facie* case of acquired distinctiveness, which is unsurprising, given that there is no such requirement. To the contrary, the Federal Circuit has instructed that to show acquired distinctiveness of a color mark, an applicant must show a “syndetic relationship” between the mark and a single source in the minds of “a significant part of the purchasing public.” *In re Owens-Corning Fiberglas Corp.* at 424 (Fed. Cir. 1985). Applicant’s survey evidence shows such a syndetic relationship between the Cheerios Yellow Box Mark and Applicant specifically (not just a single source) at a rate consistent with or well beyond the response rates

accepted by other courts and the Board as showing secondary meaning. Applicant's evidence clearly exceeds the threshold set forth by the Federal Circuit.

Finally, Applicant notes that the Examining Attorney mentions in conclusory fashion that the probative value of a survey is weakened "if there are flaws in the way the survey is conducted" (Opp. at 12), but fails to actually identify or discuss any flaws in Applicant's survey. As such, this argument is irrelevant and effectively equates to an admission that the Examining Attorney has not identified any flaws in the survey's methodology.

Applicant's survey evidence weighs strongly, if not conclusively, in favor of a finding of acquired distinctiveness, and the Examining Attorney's failure to address this evidence and apply the proper standard with respect to the probative value of Applicant's survey is clear error.

### **Conclusion**

Applicant has demonstrated that the Cheerios Yellow Box Mark has achieved secondary meaning in the minds of the public by presenting highly probative direct and circumstantial evidence. The arguments and evidence relied upon by the Examining Attorney fall woefully short of rebutting Applicant's *prima facie* case of acquired distinctiveness, let alone proving beyond all doubt that the mark has not acquired distinctiveness, and include numerous misstatements of law and fact. The Board should conclude that Applicant's Cheerios Yellow Box Mark has acquired distinctiveness and approve the application for publication.